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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,726

02/04/2004

Terry-Lee M. Fritz

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HEWLETT PACKARD COMPANY  
P O BOX 272400, 3404 E. HARMONY ROAD  
INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER

EVANISKO, LESLIE J

ART UNIT

PAPER NUMBER

2854

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/772,726	Applicant(s) FRITZ ET AL.	
	Examiner Leslie J. Evanisko	Art Unit 2854	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/17/2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 17, 2006 has been entered.

### **Response to Amendment**

2. The declaration filed on November 17, 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Braun reference (US 2005/0068550 A1).

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Braun reference to either a constructive reduction to practice or an actual reduction to practice. In particular, it is noted that applicants state in item (5) of the declaration that the '726 patent application was drafted by HP's outside patent counsel with the applicants' collaboration prior to September 25, 2003. Additionally, applicants attach a copy of the letter of transmission of the draft application to HP's inside patent counsel (Exhibit 1) and a copy of the draft application (Exhibit 2). In view of these exhibits and statements, the declaration does

establish conception of the invention prior to the effective date of the Braun reference by showing that the draft patent application (Exhibit 2) was prepared and transmitted (Exhibit 1) prior to September 25, 2003.

However, it is further noted that applicant states in item (9) of the declaration that after the draft application was received by HP's inside patent counsel, "it was entered into the standard internal review process that is followed for all patent applications at Hewlett-Packard. After review, some changes were made to the draft and it was filed as the '726 application on February 4, 2004." However, this statement appears to be a general allegation of diligence and does not show sufficient evidence of the facts to establish diligence. Note that MPEP 2138.06 states that an applicant must account for the entire period during which diligence is required by either affirmative acts or acceptable excuses. The broad statement in item (9) of the declaration fails to provide specific facts and dates as to what occurred during the period of at least approximately 20-weeks between applicant's conception and the constructive reduction to practice when the application was filed on February 4, 2004.

Particular attention is invited to MPEP 715.07(a) and MPEP 2138.06.

Therefore, since the declaration filed November 17, 2006 is ineffective to overcome the Braun reference, the prior art rejection previously set forth in the Office Action dated August 14, 2006 is maintained as set forth below:

#### **Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 4-7, 12 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Braun (US 2005/0068550 A1). Braun teaches a method of verifying light conditions comprising viewing an article under a given light condition, wherein first and second colored markings have been printed on the article, wherein the first and second colored markings are metameretic and have the same color appearance under a first light condition, determining whether the first and second markings have the same color appearance, and thereby determining whether the article is being viewed under the first light condition. See paragraphs [0007], [0014]-[0017], and [0020] in particular.

With respect to claim 2, note Braun teaches the first and second markings are printing with first and second members of a pair of metameretic inks in paragraphs [0014]-[0016].

With respect to claim 4, note Braun teaches the first and second members of the pair of metameretic inks are spot (i.e., “pure K”) and process (i.e., “CMY combination”) inks, respectively in paragraph [0016].

With respect to claim 5, note at least one of the first and second markings of Braun is printed with a mixture of process inks (i.e., the “CMY combination”) in paragraph [0016].

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With respect to claim 6, note the teaching of Braun in paragraph [0017] that the targets are bipartite patches, concentric patches, or half-and-half images, which would inherently include the markings be printed adjacently.

With respect to claims 7 and 14, note Braun teaches printing a plurality of pairs of metameric markings, determining which markings have the same (or closest) color appearance, and thereby determining the light condition under which the article is being viewed. Again, attention is invited to paragraph [0016].

With respect to claim 12, note Braun teaches the use of a single printer (i.e., the characterized printer) for printing the markings in paragraph [0017].

### **Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3, 8, 10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braun (US 2005/0068550 A1) in view Beck (GB 1 407 065). With respect to claim 3, note that although Braun does not specifically teach the first and second members of the pair of metamerics inks are both spot inks as recited. Note Braun teaches the use of spot and process inks to print metamerics markings in paragraph [0016] and additionally states that "other color combinations will also work." Furthermore, Beck teaches the use of spot inks for printing a pair of metamerics markings is well known in the art, as exemplified by the teachings in page 4, line 37 through page 25. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the first and second members of the pair of metamerics inks of Braun be printed with spot inks as taught by Beck as it would simply require the obvious substitution of one known ink for another to provide a simplified process for printing metamerics markings since spot inks are essentially "pre-mixed" ink compositions (as opposed to marks made by process inks which require the separate ink colors to be mixed during the printing process to achieve a particular colored mark).

With respect to claim 8, although Braun is silent with respect to whether the second and third markings are the same, note Beck teaches printing a plurality of metamerics inks such that the marks are substantially identical in lines 24-33 of page 4.

With respect to claim 10, although Braun is silent with respect to the particular details of the article being printed and whether it is a fabric or paper article, the printing

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of metamerism upon substrates such as fabrics or paper is well known in the art, as exemplified by Beck in page 3, lines 108-119. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the article being printed in the process of Braun to be a fabric or paper article as taught by Beck to provide an accurate method of verifying light conditions for fabric or paper articles printed with metamerism marks.

With respect to claim 13, although Braun does not specifically teach printing the first and second markings with one printer and the third and fourth markings with a second printer, note Beck teaches that various metamerism markings using different printing arrangements is well known in the art, as exemplified by the teachings in page 2, lines 76-114. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide the metamerism markings in Braun to be printed by different printing apparatus or arrangements as taught by Beck such that printing of multiple markings can be achieved simultaneously or with less down time to exchange ink cartridges, resulting in quicker production of the printed articles.

### **Conclusion**

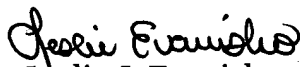
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is (571) **272-2161**. The examiner can normally be reached on T-F 8:00 am-6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Leslie J. Evanisko  
Primary Examiner  
Art Unit 2854

lje  
December 20, 2006